

PATENT COOPERATION TREATY

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INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 62260A	FOR FURTHER ACTION	
	See Form PCT/IPEA/416	
International application No. PCT/US2004/012427	International filing date (day/month/year) 21.04.2004	Priority date (day/month/year) 25.04.2003
International Patent Classification (IPC) or national classification and IPC C08G18/36, C08G18/42, C08G18/48		
Applicant DOW GLOBAL TECHNOLOGIES INC. et al		

1. This report is the International preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 4 sheets, including this cover sheet.
3. This report is also accompanied by ANNEXES, comprising:
 - a. *(sent to the applicant and to the International Bureau)* a total of sheets, as follows:
 - sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).
 - sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.
 - b. *(sent to the International Bureau only)* a total of (indicate type and number of electronic carrier(s)), containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).
4. This report contains indications relating to the following items:
 - Box No. I Basis of the opinion
 - Box No. II Priority
 - Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
 - Box No. IV Lack of unity of invention
 - Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - Box No. VI Certain documents cited
 - Box No. VII Certain defects in the international application
 - Box No. VIII Certain observations on the international application

Date of submission of the demand 07.01.2005	Date of completion of this report 18.03.2005
Name and mailing address of the International preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized Officer Heidenhain, R Telephone No. +49 89 2399-8673



**INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY**

International application No.
PCT/US2004/012427

Box No. I Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
 - This report is based on translations from the original language into the following language, which is the language of a translation furnished for the purposes of:
 - international search (under Rules 12.3 and 23.1(b))
 - publication of the international application (under Rule 12.4)
 - international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the elements* of the international application, this report is based on (*replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report*):

Description, Pages

1-45 as originally filed

Claims, Numbers

1-44 as originally filed

a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing

- The amendments have resulted in the cancellation of:
 - the description, pages
 - the claims, Nos.
 - the drawings, sheets/figs
 - the sequence listing (*specify*):
 - any table(s) related to sequence listing (*specify*):
- This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
 - the description, pages
 - the claims, Nos.
 - the drawings, sheets/figs
 - the sequence listing (*specify*):
 - any table(s) related to sequence listing (*specify*):

* If item 4 applies, some or all of these sheets may be marked "superceded."

**INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY**

International application No.
PCT/US2004/012427

Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes:	Claims	
	No:	Claims	1-4,6-9,12-14,16,17,19,21-33,41-44
Inventive step (IS)	Yes:	Claims	
	No:	Claims	5,10-11,15,18,20,34-40
Industrial applicability (IA)	Yes:	Claims	1-44
	No:	Claims	

2. Citations and explanations (Rule 70.7):

see separate sheet

**INTERNATIONAL PRELIMINARY
REPORT ON PATENTABILITY
(SEPARATE SHEET)**

International application No.
PCT/US2004/012427

Re Item V:

- 1 The following documents are referred to in this communication:
D1 : EP 0 106 491 A (HENKEL CORP) 25 April 1984 (1984-04-25)
D2 : US 4 534 907 A (ROGIER EDGAR R ET AL) 13 August 1985 (1985-08-13)
- 2 The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 1 is not new in the sense of Article 33(2) PCT. Document D1 discloses non-gelling polyols which are useful in the preparation of polyurethanes. These polyols correspond structurally to the formula $R-[-X-(-A-)_a-H]_p$; $p=2-6$ and $a=0-10$ and $X= -O-, -N-, -NH-$ and A may be A_1, A_2, A_3 of the same structure as defined in the present application. These materials are obtained by reacting hydroxymethylated fatty acid (ester) derived monomers with polyols or polyamines ("initiators") in the sense of an transesterification reaction. The polyols or polyamines to be used are defined in claim 4 of D1. It follows that D1 is novelty anticipating for claims 1-4, 6-9, 12-14, 16, 17, 19, 21-33 and 41-44 of the present application. The same applies for D2 which is a closely related document to D1 from the same inventors.
- 3 D1 mentions certain problems which arise when secondary hydroxyls are present in the initiator molecule (D1, page 12, line 12-21). Glycerol, a secondary OH-group containing triol, is explicitly excluded as potential initiator from the teaching of D1 (D1; page 5, lines 2-4; claim 13). Thus, a new set of claims based on present claims 5 or 10 could be regarded as novel over D1 (and also over D2). Such a claim however, in order to be regarded as involving an inventive step, needs to provide the solution to a technical problem taking in consideration the closest prior art D1. From the provided evidence it cannot be derived which technical problem is solved by the distinguishing feature of a new claim as proposed. Therefore no inventive step is recognisable for claims 5, 10-11, 15, 18, 20 and 34-40 of the present application (Art. 33,3 PCT)